



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,141	08/21/2001	Myron Spears	58628.000002	4926

7590 10/24/2006
Kevin T. Duncan, Esq.
Hunton & Williams
Suite 1200
1900 K Street
Washington, DC 20006-1109

EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/933,141	Applicant(s) SPEARS, MYRON	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-21 have been examined in this application. This Final Office Action is in response to the "Amendment" and "Remarks" filed on September 5, 2006.

Election/Restrictions

2. Newly submitted claims 18-21 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1-17 are directed towards an online method for presenting a plurality of health related goods or services offered by one or more offers to a user for viewing and selecting at a remote terminal while Claims 18-21 are directed towards a method of online claim payment or online premium or payment contribution.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-11 and 13-15 are rejected under 35 U.S.C. 102(a) as being unpatentable by over US Patent Number 6,735,569 to Wizig.

Art Unit: 3626

(A) As per claim 1, Wizig teaches an online method for presenting one or more health related goods or services offered by one or more offerors to a user for viewing and selecting at a remote terminal (Wizig: Abstract), the method comprising the steps of:

- a) storing in a storage device at a central location health product related information pertaining to one or more health related goods or services (Wizig: Col. 6, Ln. 4-13);
- b) establishing an electrical communication between the central location and the remote terminal (Wizig: Col. 6, Ln. 4-13);
- c) determining at the central location if the user of the remote terminal is a registered user, and if the user is not registered presenting the unregistered user with a user profile inquiry, whereby an unregistered user uploads to the central location user profile data and satisfies other registration requirements, the user profile being received and stored at the central location (Wizig: Col. 7, Ln. 58-Col. 8, Ln. 7);
- d) presenting to and viewing by the registered user at the remote terminal information, based at least in part on the user profile, pertaining to health related goods or services (Wizig: Col. 4, Ln. 4-13);
- e) the user remotely selecting a particular health related good or service (Wizig: Col. 15, Ln. 63-Col. 16, Ln. 8);
- f) the central location presenting the user with cost information related to the selected health related good or service (Wizig: Col. 17, Ln. 11-13); and
- g) the user repeating the viewing and selecting steps to build a health benefits package based upon options available to the user (Wizig: Col. 12, Ln. 24-28).

Art Unit: 3626

(B) As per claim 2, in Wizig at least one of the health related goods and services available to the user represents a health insurance product made available by an employer to its employees, the user being one of the employees (Wizig: Col. 12, Ln. 24-28).

(C) As per claim 3, in Wizig at least one of the health related goods and services available to the user is a generally available good or service made available based on qualifying data (Wizig: Col. 13, Ln. 35-41).

(D) As per claim 4, in Wizig the user profile inquiry comprises one or more of user name, employer information, user health history data, family member information, family health information and email address (Wizig: Col. 8, Ln. 30-39).

(E) As per claim 5, in Wizig at least one of the health related goods and services available to the user represents at least one of dental insurance, life insurance and disability insurance products (Wizig: Col. 6, Ln. 35-45).

(F) As per claim 6, in Wizig the health benefits package involves at least one of a flexible savings account and a medical savings account (Wizig: Col. 6, Ln. 35-45).

(G) As per claim 7, Wizig teaches an online system operated over a distributed computer network, the network comprising at least one server at a central location accessible to remote users over the network via remote terminals, and a storage device in communication with the server, a method comprising the steps of:

a) receiving and storing at the central location electronic information concerning at least one health related good or service from at least one offeror to be made available to remote users (Wizig: Col. 6, Ln. 4-13);

Art Unit: 3626

- b) establishing an electrical communication between the central location and a remote terminal over the network (Wizig: Col. 6, Ln. 4-13);
 - c) determining at the central location if the user of the remote terminal is a registered user, and if the user is not registered presenting the unregistered user with a user profile inquiry, whereby an unregistered user uploads to the central location user profile data and satisfies other registration requirements, the user profile being received and stored at the central location (Wizig: Col. 7, Ln. 58-Col. 8, Ln. 7);
 - d) presenting, based at least in part on the user profile, information related to one or more of the at least one health related good or service (Wizig: Col. 7, Ln. 4-13);
 - e) selecting by the user at the remote terminal at least one presented health related good or service and transmitting a request to the central location to receive additional information related to the selected health related good or service (Wizig: Col. 15, Ln. 63-Col. 16, Ln. 8);
 - f) the user repeating the viewing and selecting steps to build a health benefits package based upon options made available to the user (Wizig: Col. 16, Ln. 27-46); and
 - g) storing at the central location information about the user health benefits package (Wizig: Col. 6, Ln. 4-13).
- (H) As per claim 8, in Wizig the options made available to the user are comprised of insurance products made available to the user by the user's employer (Wizig: Col. 13, Ln. 35-41).
- (I) As per claim 9, in Wizig the options are one or more of the group consisting of health, dental, life and disability insurance products (Wizig: Col. 6, Ln. 35-45).

Art Unit: 3626

(J) As per claim 10, in Wizig the user profile inquiry comprises one or more of user name, family member information, employer information, user health history information, family health history information, and email address (Wizig: Col. 8, Ln. 30-39).

(K) As per claim 11 in Wizig the user is presented with information related to deductible and cost for one or more health related good or service (Wizig: Col. 6, Ln. 31-34).

(L) As per claim 13, Wizig teaches an online system for presenting health related goods or services over a distributed network, the health related goods or services being presented over the distributed network to remote users (Wizig: Abstract), the system comprising:

a central location comprising at least one server and having at least one processor and at least one database, the at least one database for storing data related to the health related goods or services and user profile information, the central location server having a communication device for establishing electrical communications with remote users over the distributed network;
a remote terminal operated by a remote user and having a display and a data entry device, the remote terminal further having a communication device for establishing communication with the central location over the distributed network, the user having profile data stored at the central location (Wizig: Col. 6, Ln. 4-13 and Col. 7, Ln. 58-Col. 8, Ln. 40); and

the central location further comprising a package module adapted to generate a user package comprising cost and deductible data associated with at least one health related good or service based at least in part on the remote user's profile data, the central location presenting the package to the user (Wizig: Col. 3, Ln. 42-63);

wherein the remote terminal displays the package information received from the central location to the user, the user communicating selection input via the data entry device in response to the displayed package information (Wizig: Col. 6, Ln. 15-24).

(M) As per claim 14, in Wizig the package includes at least one of health insurance, dental insurance, life insurance and disability insurance products (Wizig: Col. 6, Ln. 35-45).

(N) As per claim 15, in Wizig the package made available to the user is at least in part subject to the user's employer benefits offerings (Wizig: Col. 12, Ln. 24-28).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig, as applied to Claim 7, above, and in further view of US Patent Number 6,134,548 to Gottsman.

(A) As per claim 12, Wizig not teach the steps of allowing the user to select at least two competing health related goods or services; comparing at the central location the at least two competing health goods or services; and presenting to the user information pertaining to the comparative results; however, this feature is well known in the art as evidenced by Gottsman (Col. 1, Ln. 54-57 and Col. 1, Ln. 67-Col. 2, Ln. 5). At the time of the invention, it would have been obvious for one of ordinary skill in the art included the aforementioned feature from Gottsman in the method of Wizig with the motivation of providing a user with a means of web-based comparison shipping as recited in Gottsman (Col. 1, Ln. 55-57).

7. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig, as applied to Claim 13, and in further view of US Patent Number 6,134,548 to Gottsman.

(A) As per claim 16-17, the system of Wizig does not include a comparison module adapted to compare at least two competing health related goods or services and to generate comparative results, the central location transmitting the comparative results to the remote terminal for viewing by the user. Wizig also does not teach a means which enables a user to select a desired health related good or service upon viewing the comparative results; however, this features are taught in Gottsman (Col. 1, Ln. 54-57 and Col. 1, Ln. 67-Col. 2, Ln. 5). At the time of the invention, it would have been obvious for one of ordinary skill in the art included the aforementioned feature from Gottsman in the system of Wizig with the motivation of providing a user with a means of web-based comparison shipping as recited in Gottsman (Col. 1, Ln. 55-57).

Response to Arguments

8. Applicant's arguments filed on September 5, 2006 have been fully considered but they are not persuasive.

Applicants essentially argue that neither Wizig nor Gottsman disclose providing a user with a plurality of health related goods or services allowing the user to repeatedly "select" desired and available goods and services to thereby "build" a benefits package as required by thee claim. The applicants further argue that Wizig and Gottsman do not teach a step wherein a user "builds" a package by successive viewing and selecting steps.

To respond to these arguments the examiner takes the position that Wizig does in fact teach these features because Wizig teaches "building" a benefits package and Wizig also teaches successively viewing the package and making and/or modifying the selections (Wizig: Col. 16,

Art Unit: 3626

Ln. 9-46). Wizig states that a user can modify the benefits package which they have built and it is inherent from this step Wizig allows a user to, therefore, “build” a package by successive viewing and selecting steps.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner’s supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled “Box AF”).


Art Unit: 3626

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,


Vivek Koppikar

10/10/2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

~~JOSEPH THOMAS~~
~~SUPERVISORY PATENT EXAMINER~~